

Appl. No. : 10/017,920
Filed : December 11, 2001

RECEIVED
CENTRAL FAX CENTER
DEC 06 2006

REMARKS

The following remarks are responsive to the July 7, 2006 Office Action. Claims 2-6, 8-11, 20-21, 23-27, 30-31 remain as presented in the paper filed April 17, 2006; Claim 28 has been amended herein; Claim 32 has been canceled. As a result, Claims 2-6, 8-11, 20-21, 23-28, and 30-31 remain pending in the present application. Applicants respectfully request the Examiner to reconsider the application in view of the following comments.

Allowable Subject Matter

Applicants gratefully acknowledge the Examiner's allowance of Claims 2-6, 8-11 and 20-21 in the Office Action. Applicants further acknowledge the Examiner's statement that Claim 28 would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims. Applicants have amended Claim 28 to include all the limitations of the base claim and any intervening claims. Accordingly, Applicants respectfully request that Claim 28 be allowed.

Rejection of Claims 23, 25-27, 30 and 31 under 35 U.S.C. §102

In the Office Action, the Examiner rejected Claims 23, 25-27, 30 and 31 under 35 U.S.C. § 102 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,616,692, issued to Glick et al ("Glick"). Applicants respectfully traverse this rejection.

Applicants submit that Glick does not disclose or suggest all the limitations recited by Claim 23. For example, Applicants submit Glick does not teach or suggest "a posterior optic having a larger diameter than said anterior optic," as recited by Claim 23.

In rejecting Claim 23, the Examiner relies on an inspection of the drawings of Glick to find disclosure therein of the claimed relative sizes of the anterior and posterior optics. Applicants respectfully submit that the rejection of Claim 23 is contrary to M.P.E.P. § 2125, which states that "proportions of features in a drawing are not evidence of actual proportions when drawings are not to scale." The same section also cites Federal Circuit case law (Hockerson-Halberstadt, Inc. v. Avia Group Int'l, 222 F.2d 951 (Fed. Cir. 2000)), which is particularly relevant here.

Appl No. : 10/017,920
Filed : December 11, 2001

In Hockerson, the patentee sought to enforce a patent directed to an athletic shoe. The inventive shoe featured a heel bisected by a central longitudinal groove, thus creating two peripheral "fins," one on either side of the groove. At issue was whether the claims of the patent should be interpreted to cover only shoes featuring a central groove with a width that is narrower than the combined width of the "fins." The patentee argued that such a narrow interpretation of the claims was incorrect because, inter alia, the specification contained figures depicting a groove that is wider than the fins. However, the Federal Circuit refused to draw any such inferences from the patent drawings, stating:

The [patent at issue] is devoid of any indication that the proportions of the groove and fins are drawn to scale. [The patentee's] argument thus hinges on an inference drawn from certain figures about the quantitative relationship between the respective widths of the groove and fins. Under our precedent, however, it is well established that patent drawings do not define the precise proportions of the elements and may not be relied on to show particular sizes if the specification is completely silent on the issue.

Glick does not state whether the drawings are to-scale, nor does Glick discuss the relative sizes of the optics in the specification. Accordingly, Applicants respectfully submit that independent Claim 23 is patentably distinguishable over Glick. Each of Claims 24, 25, 27, 30, and 31 depend directly from Claim 23 and, therefore, is patentable over Glick for at least the same reasons that Claim 23 is patentable over Glick.

Although independent Claim 26 recites a different combination of limitations than Claim 23, Applicants further submit that Claim 26 is in condition for allowance for at least the reasons stated above with regard to Claim 23.

Accordingly, allowance of Claims 23, 25-27, 30, and 31 is respectfully requested.

Rejection of Claim 24 under 35 U.S.C. § 102(e) & 35 U.S.C. § 103(a)

In the Office Action, the Examiner rejected Claim 24 as being unpatentable over Glick either under 35 U.S.C. §102(e) or 35 U.S.C. §103(a). Applicants respectfully traverse these rejections.

Appl. No. : 10/017,920
Filed : December 11, 2001

As discussed above, Applicants submit that Glick does not disclose or suggest all the limitations recited by independent Claim 23. Therefore, Claim 23 is patentable over Glick. Claim 24 depends directly from Claim 23 and, therefore, is patentable over Glick for at least the same reasons that Claim 23 is patentable over Glick. Applicants respectfully request the Examiner to withdraw the rejection of Claim 24.

CONCLUSION

For the foregoing reasons, the Applicants respectfully submit that the present application is in condition for allowance, and the Applicants respectfully request that a Notice of Allowance be issued at the earliest opportunity.

Applicants respectfully traverse each of the Examiner's rejections and each of the Examiner's assertions regarding what the prior art shows or teaches. Although amendments have been made, no acquiescence or estoppel is or should be implied thereby. Rather, the amendments are made only to expedite prosecution of the present application, and without prejudice to presentation or assertion, in the future, of claims on the subject matter affected thereby. Any arguments in support of patentability and based on a portion of a claim should not be taken as founding patentability solely on the portion in question; rather, it is the combination of features or acts recited in a claim which distinguishes it over the prior art.

Should the Examiner have any remaining concerns which might prevent the prompt allowance of the application, the Examiner is respectfully invited to contact the undersigned at the telephone number appearing below.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: December 6, 2006

By: 

Andrew M. Douglas
Registration No. 51,212
Attorney of Record
Customer No. 20,995
(949) 760-0404

3177150 // 120406